

The 35 U.S.C. §112, Second Paragraph, Rejection

Claims 8-15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action asserts that claim 8 is indefinite as it is not clear as to how the components (a) and (b) are laminated together. Applicants traverse.

Claim 8 is directed to a multi-component graphic article having both an imageable component and an attachment component. The subject matter of the claim is clearly directed to the multi-component article and *not* to how the components are coupled, i.e., the claim does not recite that the components are attached.

As the M.P.E.P. states, the primary purpose of the requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent (see M.P.E.P. § 2173). Whether more suitable language exists or not is immaterial (see M.P.E.P. § 2173.02). Applicants submit that the claims clearly delineate to the public what Applicants regard as the invention.

For at least these reasons, Applicants submit that claim 8 and the claims that depend therefrom (claims 9-15) satisfy the requirements of 35 U.S.C. § 112, second paragraph, and notice of the same is respectfully requested.

The 35 U.S.C. § 103 Rejection

Claims 1-24 and 31-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Andriash (U.S. Patent No. 5,679,435) in view of Bull (WO 97/43128). Applicants traverse.

In each of independent claims 1, 8, 16, and 31, a multi-component article is claimed including an attachment component having a transparent scrim layer with a layer of pressure sensitive adhesive (PSA) on a first side and a layer of hot melt adhesive on a second side.

To establish *prima facie* obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

Andriash is directed to vision control panels and methods of making such panels. The embodiment of Figure 2, which the Office Action identifies in support of the rejection, describes a vision control panel 14 consisting of a retro-reflective sheet material 12 containing particles printed to form an image with light permeable translucent inks to allow reflected light to pass through the inks. A double-sided clear transfer adhesive 13 is placed over the image surface of the sheet material after image printing but before perforation. A removable backer sheet 24 is attached to the transfer adhesive which may be removed just prior to application to the inside of window glass. On the opposite side of the sheet material 12, there is a dark colored adhesive 15 with a removable backer sheet 16 attached thereto. The composite structure with image is perforated with a laser. The removable backer sheet 16 is removed and a clear laminate with UV chemical inhibitors, but without any adhesive coating, 19, is then laminated to the dark colored adhesive 15 to seal the structure from dirt. Removable backer sheet 24 is removed and the panel pressed against the inside surface 17 of a window 18.

The background section of Bull relied upon in the Office Action describes the need to protect an imaged substrate from abrasion and ultraviolet light. To this end, "[a]n optically clear transparent overlamine, comprising an optically clear, transparent durable film covered on a major surface by an optically clear, transparent pressure sensitive adhesive, is preferably applied over the image on the durable substrate." See page 1, lines 18-22. In describing the overlamine, the background section of Bull states that "[s]ome of the clear transparent overlaminates include a vinyl or polyester film covered with a pressure sensitive adhesive," which is in turn "protected by a paper or polyester liner until usage." The background section of Bull further states that other clear, transparent overlaminates may "include a vinyl or polyester film covered with a hot melt adhesive, and a scrim liner to prevent blocking." Page 1, lines 25-29.

Applicants thus submit that the background section of Bull is clearly directed to *overlaminates* used to cover imaged substrates in order to provide abrasion and/or ultraviolet light protection. That is, the overlaminates taught by the background section of Bull are directed to a clear film having an adhesive (either PSA or hot melt) on only one side, not a scrim with a PSA on one side and a hot melt adhesive on the other side. As further support for this interpretation of the teachings of the background section of Bull, Bull states that the overlaminate structure may be replaced by a vinyl/acrylic protective clear coat to provide protection to the underlying substrate. See page 1, lines 30-34. Applicants provided clarifying statements regarding Bull in the declaration under 37 C.F.R. § 132 filed 17 April 2001 (further discussed below).

The Office Action, nonetheless, alleges, with regard to the background section of Bull (page 1, lines 25-30), that "it would have been obvious to one having ordinary skill in the art to utilize Bull's teaching of using a transparent cover film adhered to the image layer in the invention of Andriash using hot melt adhesive to prevent blocking and the cover . . . in turn has a PSA layer on its exposed surface to secure the cover to the release liner" (Office Action, paragraph 2). Applicants respectfully traverse.

It is assumed that, when the Office Action refers to the "cover" or "cover film" of the background section of Bull, it is referring to the clear film having an adhesive on one side as described above. It is further assumed that the Office Action is alleging that the item identified as reference numeral 13 (see Figure 2 of Andriash) may be replaced with this cover film. However, reference numeral 13 is not a cover film but is rather identified as a double-sided clear *transfer adhesive* (column 5, lines 58-59). As a result, there is no cover or substrate layer operable to have a different adhesive on opposing sides. Rather, there is only a single layer of adhesive which is transferred to the sheet material 12.

Moreover, even if one were to combine Andriash with the cited portions of Bull as asserted in the Office Action, the combined teachings fail to teach or even suggest a film having an adhesive on two opposing sides. Rather, Bull teaches overlaminates, i.e., protective films

having an adhesive on only one side for adherence to an imaged substrate. Having an adhesive on both sides would render the articles discussed in the background section of Bull undesirable as overlaminates. Stated alternatively, the background section of Bull does not, among others, disclose or even suggest the hot melt adhesive/scrim layer/PSA structures claimed by Applicants.

Where the proposed modification of an alleged prior art invention renders the invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification (see M.P.E.P. § 2143.02).

Applicants further note that the cited portion of Andriash specifically teaches a perforated transfer adhesive (see e.g., Figure 2, column 5, line 65 - column 6, line 3). Yet, the overlaminates of the background section of Bull are necessarily unperforated to ensure protection of the underlying image. The Office Action offers no motivation as to why one of skill would look to combine the unperforated overlaminates taught by the background section of Bull with the perforated vision control panels of Andriash.

For at least the above reasons, Applicants respectfully submit that a *prima facie* case of obviousness is unsupported with respect to claims 1, 8, 16, and 31. Further, claims 2-7, 9-15, 17-24, and 32-35 are nonobvious not only because of their dependence but further because of the distinct features claimed therein. For at least the above reasons, reconsideration and withdrawal of these rejections are respectfully requested.

Comments On Examiner's Statements Regarding Previously Submitted Declaration

The Examiner alleges, at paragraph 4 of the Office Action, that the declaration filed 17 April 2001 is insufficient to overcome the rejection of claims 1-24 and 31-35 as Ms. Bull "fails to present facts as to how . . . the cover layer, in WO-97/43128 [the Bull] reference, is releasably held onto a release liner in the absence of PSA." Applicants respectfully traverse this assertion and respectfully request reconsideration of the declaration in view of the following remarks.

Various methods for releasably securing a liner or "scrim" to a hot melt adhesive layer are known. In fact, the figures of the instant application clearly illustrate a liner secured to a hot melt

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adhesive in the absence of a PSA (see e.g., hot melt adhesive layer 40 and liner 42 in Figure 1 and described at page 10, lines 24-26). This may be accomplished, for example, by casting a hot melt adhesive layer directly onto the liner and then fusing the adhesive and liner together, or by securing the liner via other mechanisms, e.g., electrostatic force.

For at least this reason, Applicants request reconsideration of the previously submitted declaration.

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Summary

It is respectfully submitted that the pending claims 1-24 and 31-35 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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